



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,422	07/02/2001	Hiroaki Shinohara	50R4615	1895

7590 06/30/2006

John L. Rogitz
Rogitz & Associates
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

JUN 30 2006

Technology Center 2600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

JUN 30 2006

Technology Center 2600

Application Number: 09/898,422
Filing Date: July 02, 2001
Appellant(s): SHINOHARA, HIROAKI

John L. Rogitz #33,549
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/10/2006 appealing from the Office action mailed 3/14/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,541,738	Roy J. Mankovitz	07-1996
6,163,316	Robert T. Killian	12-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7, 9-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz in view of Official Notice.

Mankovitz discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in the present claims 1, and 9-10, including the feature of the player including media stored content including text information (See the capability of playing both stored video information and program guide information where the program guide information would include text information such as the title of the program as shown in Mankovitz's Figure 7), the feature of the TV communicating with the player (See the capability of displaying the video information on a display apparatus as disclosed in Mankovitz), and the feature of the personal video recorder including a processor accessing a database to record at least one broadcast program based at least partially on a viewer-selected portion of the text as specified in the present claims 1, and 9-10. (See the capability of performing schedule recording of broadcasted programs in the recorder based on user selection of specific programs information from the displayed program guide information as shown in Mankovitz's column 10, lines 40-51).

Although Mankovitz discloses the capability of playing media content stored on a recording medium, Mankovitz however, fails to disclose the feature of the player as being a DVD player as specified in the present claims 1, and 9-10.

Examiner takes Official Notice in that it is notoriously well known in the video recording/reproducing art to have a DVD player connected with a TV for the purpose of playing and displaying media content retrieved from disk recording medium as specified in the present claims 1 and 9-10.

It would have been obvious to one skilled in the art to modify the Mankovitz's apparatus wherein the player provided thereof (See Mankovitz's Figure 1, component 40) would be replaced by a DVD in a manner to record and reproduce media content on and from the medium provided thereof in the same conventional manner as is well known in the prior art. Examiner has taken Official Notice. The motivation is increase the recording density of the recording medium as suggested in the prior art.

With regard to claim 3, the feature of the input device manipulate to establish the selected portion as specified thereof is present in the proposed combination of Mankovitz and Official Notice indicated above. (See Mankovitz's Figure 1, component 75).

With regard to claim 7, it is noted that all the feature recited thereof are present in the proposed combination of Mankovitz and Official Notice indicated above, including the feature of the program information being audio and video program information as specified thereof. (See the capability of receiving television program data in Mankovitz's

Figure 1, components 64, 63, wherein such television program information would be inherently include video and audio data).

With regard to claim 8, the feature of storing the viewer selection to at least one viewing history stored in the PVR as specified thereof would be inherently present in the proposed combination indicated above. Because, the Mankovitz's apparatus would forcedly include the capability of storing in the recording means provided thereof the viewer's selection of video programs (EPG) so as to be able to set up the schedule recording operation in the Mankovitz's recording system.

3. Claims 5-6, and 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankovitz and Official as applied to claim 1 above, and further in view of Killian.

The proposed combination of Mankovitz and Official Notice indicated above does disclose a recording/reproducing apparatus that shows substantially the same limitations recited in the present claims 5-6, and 11, including the feature of receiving broadcasted program information from a database (in this proposed combination the database is interpreted as the broadcasting station itself) and recording the same on a recording means based on viewer selected portion of text information such as a EPG as specified in this present claims 5-6, and 11. (See the above rejection of claim 1, particularly the capability of performing schedule recording based on viewer selected portion of text information such as a EPG).

The proposed combination of Mankovitz and Official Notice indicated above fails to specifically disclose the feature of updating said database with information available on a WAN as specified in the present claims 5-6, and 11.

Killian discloses a video recording/reproducing apparatus including said feature of updating said database with information available on a WAN. (See Killian's Figure 1, where it is disclosed the capability of updating database information through the Internet).

It would have been obvious to one skilled in the art to modify the proposed combination indicated above wherein the database (Broadcasting station) can be updated through the internet in the same conventional manner as shown by Killian. The motivation is to be able to provide most recent program information to the viewer at any desired time as suggested by Killian.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Killian.

Killian discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 12-13, including the feature of linking content to viewing and or shopping recommendations and the feature of automatically accessing a source of recommended viewing and/or shopping based on viewer's selection of characters data

that are part of a DVD content as specified in the present claims 12-13. (See Killian's Figure 3, and column 10, line 61, to column 11, line 21, and column 7, lines 33-48).

With regard to claim 15, the feature of selecting is a user input device as specified thereof is present in Killian. (See Killian's Figure 1, component 42, and column 4, lines 55-64, and column 9, lines 36-42).

With regard to claim 17, the feature of the recorder as specified thereof is shown in Killian's Figure 1, component 26).

With regard to claim 18, the feature of the source of recommended viewing and/or shopping communicates with a WAN as specified thereof is present in Killian. (See Killian's Figure 1, component 14).

With regard to claim 19, the feature of playing media stored content on a storage medium and sending the same to a television as specified thereof is present in Killian. (See Killian's Figure 1, components 20, 26, and 40).

(10) Response to Argument

In re page 4, Appellant states, "claim 1 allows a user to select content from a DVD (which typically does not include EPG content)."

In response the Examiner disagrees. Both DVD and VCR include EPG content for displaying programme data, for example, menu, schedule, title, to simply point and click. Note that EPG stands for Electronic programmable Guide, and the guide displays as a text in order to select user preferences for viewing and/or recording. The cited

reference of Mankovitz discloses in column 10 lines 40-51 that user selects text using remote control in order to record the desired program.

In re page 4, Appellant states, " Mankovitz does not appear to teach a PVR or a DVD."

In response the Examiner disagrees. Mankovitz does not teach DVD as stated in the Final Office Action. However Mankovitz teaches the VCR 10 records the desired program using EPG. It is shown in Fig. 1 of Mankovitz that the VCR performs recording and reproducing. Claim 1 of the present application does not recite the PVR as a separate unit from the DVD player. Therefore the cited reference player is built in the recorder and performs the function as claimed in the present application.

Official Notice is taken because the use of DVD type media is well known in the art to increase the recording density. Therefore it would have been obvious to one skill in the art at the time the invention was made to modify Mankovitz by utilizing DVD to take advantage of the higher storage data capacity.

In re page 5, Appellant states "Mankovitz envisions using a broadcast EPG, replacing a broadcast recorder like VCR with read-only DVD would not work in Mankovitz."

In response the Examiner disagrees. Mankovitz discloses a microprocessor controller which comprises a read-only memory for storing a control program to implement methods of the invention (see col. 3 lines 24-41 and line 60-col. 4 line 8).

In re page 6, Appellant states "Appellant is not claiming a DVD in a vacuum."

Mankovitz system has the capability of both playing and recording data, and display video information on a display apparatus.

In re page 7, Appellant states "it does not appear from the relied-upon figure 1 of Killian that broadcast content is received from anything other than a conventional broadcast source, as opposed to the internet."

In response the Examiner disagrees. See Internet 14 in fig. 1. Database server 46 coupled to the internet access program listing database 48, which contains television programming information that is periodically updated.

In re page 7, Appellant states "nothing in Killian remotely suggests recording or recommending content based on a user selecting text from a DVD or other player."

In response the Examiner disagrees. Killian discloses a video recording/reproducing apparatus that shows all the limitations recited in claims 12-13, including the feature of linking content to viewing and or shopping recommendations and the feature of automatically accessing a source of recommended viewing and/or shopping based on viewer's selection of characters data that are part of a DVD content as specified in the present claims 12-13. (See Killian's Figure 3, and column 10, line 61, to column 11, line 21, and column 7, lines 33-48).

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

Art Unit: 2621

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Helen Shibru

helen shibru
June 21, 2006

Conferees:

Thai Tran

Supervisor

For
James Groody

Supervisor

[Signature]
THAI TRAN
PRIMARY EXAMINER

Robert Chevalier
ROBERT CHEVALIER
PRIMARY EXAMINER